

ESTTA Tracking number: **ESTTA356549**

Filing date: **07/06/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184529
Party	Defendant Global Tissue Group, Inc.
Correspondence Address	R. GLENN SCHROEDER HOFFMAN & BARON, LLP 6900 JERICO TURNPIKE SYOSSET, NY 11791 UNITED STATES gschroeder@hoffmannbaron.com
Submission	Reply in Support of Motion
Filer's Name	R. Glenn Schroeder
Filer's e-mail	rgsdocket@hoffmannbaron.com
Signature	/r. glenn schroeder/
Date	07/06/2010
Attachments	Reply to Opposer's Opposition to Applicant's Motion to Compel Discovery.pdf (11 pages)(581285 bytes)

)	
GEORGIA-PACIFIC CONSUMER)	
PRODUCTS LP,)	
)	
Opposer,)	Opposition No.: 91184529
)	
v.)	
)	
GLOBAL TISSUE GROUP, INC.)	
)	
Applicant.)	
)	

Applicant, Global Tissue Group, Inc. (“Global Tissue”) hereby submits its Reply to Opposer Georgia-Pacific Consumer Products LP’s (“Georgia-Pacific”) Opposition to Applicant’s Motion to Compel Discovery.

Georgia-Pacific repeatedly argues in its response that Mr. Towle fully satisfied his obligation under Rule 30(b)(6). However, what it fails to discuss in its response is the fact that the Board's earlier decision granting the 30(b)(6) deposition was based upon Georgia-Pacific's specific representation that Mr. Towle, the 30(b)(6) designee, could speak to all thirteen categories identified in the notice. Having made such a representation, a representation relied upon by this Board, Georgia-Pacific cannot now attempt to argue that Mr. Towle's lack of knowledge is acceptable under the requirement of Fed.R.Civ.P. 30(b)(6).

Georgia-Pacific states that “the only question not fully answered by Mr. Towle pertain to either (1) irrelevant issues outside of the scope of the notice of deposition topics, or (2) privileged information. This argument is contrary to any reasonable interpretation of the testimony. The deposition notice, attached as Exhibit A to Global Tissue’s moving papers, sets forth thirteen categories of topics. Global Tissue’s moving papers specifically recite thirty-two portions of the transcript covering six different topics during which Mr. Towle answered “I don’t know,” or variations thereof. None of the cited portions deal with irrelevant issues or privileged information.

Georgia-Pacific cites the decision of *Int’l Fin. Corp. v. Bravo Co.* in support of its argument. That case, however, dealt with a party who had already been ordered by the Board to request permission before filing a Motion to Compel. More to the point, there is no discussion in that case about the witness being unable to answer questions. Rather, that case apparently dealt with a party seeking to obtain a second 30(b)(6) deposition on the same topics listed in the Notice because additional documents were to be produced. Those facts are quite different from the facts at hand.

In sum, Georgia-Pacific misrepresented itself before this Board, and has failed to fulfill its obligations under Rule 30(b)(6).

II. GEORGIA-PACIFIC’S ARGUMENTS AND AUTHORITY FAIL TO SUPPORT ITS POSITION

A. Global Tissue is entitled to Complete the 30(b)(6) Deposition already Ordered by this Board

Georgia-Pacific argues that it fulfilled its obligation under Rule 30(b)(6) because it provided testimony reasonably known to the company. It cites several cases concerning the obligations of a corporate deponent to investigate facts and to prepare for a 30(b)(6)

deposition. However, a review of the cited cases indicates that such cases are inapplicable to the facts at hand. First, none of these cases involves the situation where a party made a specific representation to the controlling authority (prior to the taking of such deposition) that a particular designee would be able to answer all of the topics identified in the Notice. Second, the cases cited by Georgia-Pacific generally deal with situations where the deponent provided answers to the questions, but not to the extent desired by the deposing party. This is, of course, quite different from the situation at hand wherein Mr. Towle repeatedly answered “I don’t know,” or a variation thereof.

In fact, one of the cases cited by Georgia-Pacific, *Banks v. Office of the Senate Sergeant-at-Arms*, specifically addressed and rejected the acceptability of “I do not know” statements – noting that “courts understandably must guard against the gamesmanship of a company avoiding deposition topics by, for example, naming as a 30(b)(6) witness a person who knows nothing about the topics and does nothing to inform himself about them so that his deposition threatens to be a series of cynical ‘I do not know’ statements”. *Id.* at 375.

Georgia-Pacific states that although Global Tissue “selectively quoted a few ‘I don’t know’ answers from Mr. Towle’s entire deposition, [that] a review of the complete transcript shows that he answered the proper questions asked of him in regarding the notice of deposition topics.” This argument is simply unsupported by the facts at hand. No reasonable party would consider over forty “I don’t know” responses to constitute “a few” as argued by Georgia-Pacific.

1. The Testimony Regarding Opposer's Advertisements was Inadequate

Georgia-Pacific's suggests that Mr. Towle's testimony was adequate because "the only questions that [he] was unable to answer involved either old advertising...or photographs of product packaging that predated his arrival at the company." This argument entirely misses the point. First, Global Tissue has recited approximately twenty instances in which Mr. Towle was unable to answer questions regarding Opposer's advertisements. These unanswered questions constitute a substantial portion of the questions directed to this category. Second, a party's own descriptive usage of terminology is an important and extremely telling indication that such terminology is in fact descriptive. A party cannot be allowed to "duck" such questions simply because the advertisements predated the employee's arrival at the company. Georgia-Pacific obviously knew in advance (at the time it made its representation to this Board) that its advertisements predated Mr. Towle's arrival at the company.

Global Tissue's citation of cases in this regard fail to support its position. For example, in the cited *Fraser Yachts Florida, Inc.* decision, the Court found that the 30(b)(6) designee's testimony fell short of the requirements of Rule 30(b)(6). In fact, the Court in that decision stated that if Plaintiff was "going to designate Mr. Brand as a corporate representative, then it had an obligation to ensure that Mr. Brand familiarized himself with the subject matter of this case by reviewing relevant documents and depositions and talking to those who know the facts". The cited cases suggest that there are times when a corporation simply does not know the answer to a question – and that a 30(b)(6) designee can testify to this extent. In the case at hand, that is not the situation.

Mr. Towle did not testify that the company did not know such information. Rather, he testified that he did not know such information.

2. The Testimony Regarding Searches and Investigations was Inadequate

To begin, Georgia-Pacific states that “Global Tissue admits in its Motion that the only search report that Georgia-Pacific has in its possession pertaining to the “Quilted” marks is a search report for the mark IT’S ALL IN THE QUILTING.” Global Tissue has made no such admission, and the only purpose of such statement is to mislead this Board. Georgia-Pacific is again attempting to close down discovery regarding searches and search reports before allowing Global Tissue an adequate opportunity to investigate this area.

Georgia-Pacific attempts to explain its non-responsiveness by suggesting that relevant non-privileged information could not possibly be obtained by asking a witness about its process of clearing a mark. Such an argument is contrary to controlling legal authority, and to the rules of the TTAB. Questions regarding the process of clearing a mark may indicate whether an outside search company is used, whether hard copies of search reports were provided, whether search reports are forwarded to various individuals, whether the search reports are maintained in hard or electronic form, etc.

Finally, Georgia-Pacific’s attempt to defend its position by arguing that the requested information is privileged is unsupported by the facts at hand. Global Tissue has not and is not asking for the comments or opinions of attorneys relating to any search reports. Georgia-Pacific notes in its paper that “Mr. Towle testified in his deposition that Georgia-Pacific does have a trademark clearing process that is conducted by its in-house legal department, which then reports the **search results** to the marketing department.” Thus, it is clear that search results are reported to the marketing department. Global Tissue

is entitled to know how such search results are reported, whether such search results include copies of the actual search, to whom they are transmitted, how they are kept, etc.

3. Georgia-Pacific's testimony regarding third party usage of the term "Quilt," is inadequate

Paper towel products are clearly relevant to the proceeding at hand, and are covered by the topics in the Notice. P&G, the owner of Bounty paper towels, has the used the term "Quilt," or variations thereof, in connection with its Bounty paper towels for many years. Questions regarding this usage are clearly relevant. Georgia-Pacific suggests in its response that Global Tissue should seek such information from P&G, and notes that a subpoena has been served upon P&G. However, this attempt to shift the focus off of Georgia-Pacific is improper. Global Tissue is entitled to know what information Georgia-Pacific has regarding P&G's usage of the term "Quilt". Particularly, it is entitled to know how long Georgia-Pacific has been in possession of such information, and what action if any it has taken against P&G. If no such action has been taken, Global Tissue is entitled to know why Georgia-Pacific has not taken such action. None of this information is the possession of P&G, and would not be obtained by the issued subpoena. Georgia-Pacific's suggestion otherwise is nothing more than attempt to defend its non-responsive answers, and to "duck" its obligations under Rule 30(b)(6).

4. The Issue of Brand Awareness and Competitive Brands is Covered by the Notice of Rule 30(b)(6)

There can be no doubt but that competitive ads fall within the topic of "brand awareness and competitive brands." During his testimony, Mr. Towle confirmed that Georgia-Pacific does in fact keep copies of competitive ads. Beyond that, Mr. Towle was

unable to add any additional information. He did however identify the individuals that would have such information.

Georgia-Pacific argues that Global Tissue's document requests did not ask for production of "competitive ads." It then suggests that Document Request No. 15 might "be remotely related" to this topic. In fact, Request No. 15 is directly on point. Although Georgia-Pacific states that it has already produced any documents responsive to Request No. 15, it fails to mention that such documents were not produced until June 9, 2010, following the deposition of Mr. Towle and another demand for such documents.

Mr. Towle was also asked about certain "routine field investigations" conducted by Georgia-Pacific and mentioned in a Declaration signed by Ms. Emily Boss in 2008. Georgia-Pacific's argument that "routine field investigations" have "nothing whatsoever to do with brand awareness and competitive brands and falls clearly and squarely outside the scope of topics listed in category 7" is not understood. The Boss Declaration specifically refers to a "routine filed investigation" in the context of an investigation about one of its competitors, namely P&G. Thus, it is clear from this Declaration that Georgia-Pacific was monitoring the marketplace, that such monitoring had uncovered certain activity by P&G to which P&G was now objecting, and that it was this "routine field investigation" that uncovered such activity. For Georgia-Pacific to now argue that "routine field investigations" are not within the topic of brand awareness and competitive brands is disingenuous.

5. Prior Objections made by Georgia-Pacific are clearly within the Scope of the Deposition Notice.

Georgia-Pacific argues that certain questions were directed to an unrelated lawsuit, and are therefore irrelevant to this proceeding. Georgia-Pacific's argument is misplaced.

In 2003, Georgia-Pacific filed suit against P&G, including claims under §43(a) of the Lanham Act, based on an advertising campaign being run by P&G. The lawsuit reveals that P&G was using the term “Quilts” at that time. Inasmuch as Georgia-Pacific itself brought this proceeding, and its own complaint makes reference to usage of the term “Quilts” by P&G, questions concerning such usage are clearly appropriate in this proceeding. It should be noted that this Complaint was not produced to Global Tissue as part of the discovery process, despite specific discovery requests covering such document. Moreover, it is noteworthy that Georgia-Pacific’s response does not address any of the specific examples set forth at Pages 12-13 of Global Tissue’s moving paper. Georgia-Pacific’s attempt to categorize questions directed to an earlier lawsuit as irrelevant is contrary to the facts of such suit, and is nothing more than attempt to misdirect this Board.

6. Georgia-Pacific’s Response Fails to Address the Testimony Regarding Document No. GP032483

Page 14 of Global Tissue’s moving paper cites a portion of the transcript wherein Mr. Towle was asked about a certain document (GP 032483) produced by Georgia-Pacific. The document refers to a competitor of Georgia-Pacific. Mr. Towle was unable to answer the questions. Georgia-Pacific’s opposition papers do not contain any argument in this regard. Accordingly, Applicant is entitled to pursue this topic with a knowledgeable witness in order to complete the 30(b)(6) deposition.

B. Georgia-Pacific’s Privilege Log Does Not Comply with Rule 26

Georgia-Pacific argues that its privilege log satisfies the requirements of Rule 26(b)(5), and cites three cases in support of its argument. However, the citation of these cases, and Georgia-Pacific’s statement that “courts have held that privilege logs similar to that produced by Georgia-Pacific provided sufficient notice of the nature and the

documents withheld and privilege asserted,” is misleading. The first cited case, *Jordan v. Wyley*, simply reiterates the provisions of Rule 26(b)(5), without providing any specific examples of the nature of the privilege log in dispute in that case. The *Jordan* case does specifically note that the “documents much be sufficiently described to enable the parties to assess the claim.” Although the Court in *Jordan* found the privilege log to be acceptable, there is simply no way to apply the facts of that case to the facts of this proceeding without actually comparing that privilege log to this privilege log. The next case cited by Georgia-Pacific, namely *Cencast Servs., L.P. v. United States*, involved a case where the Court found the privilege to be acceptable after conducting an *in camera* review. No such review has been conducted in the proceeding at hand. Moreover, in that case, the description of the documents was substantially more detailed than the description of the documents in the privilege log at hand. Here, usage of the overly broad terms “testing”, “legal advice/review” and/or “enforcement” provides significantly less detail than the document descriptions in the *Jordan* case, and no in camera review has been conducted by the TTAB.

The final case cited by Georgia-Pacific, namely *Grand Jury Investigation v. The Corporation*, is a decision dated August 31, 1992 from the 9th Circuit. Georgia-Pacific’s citation reliance upon this decision is not understood inasmuch as this decision predates the 1993 amendments to the federal rules which added Rule 26(b)(5). The citation of *Grand Jury Investigation* with respect to issues involving privilege log is simply improper.

Georgia-Pacific argues that Mr. Towle should not have been expected to identify a particular document on the privilege log of which he was the sole recipient. They argue that it is “highly unreasonable to expect Mr. Towle to specifically recall one email of the thousands he receives each year”. Thus, it is Georgia-Pacific’s position that although a

high level employee of Georgia-Pacific and the recipient of a particular document cannot identify a particular document (because he receives a lot of documents each year), that nonetheless Global Tissue is expected to be able to identify such document in order to make a determination regarding the claim of privilege allegedly attached to the document. Such an argument should be rejected by this Board.

It is therefore respectfully requested that the Board direct of Georgia-Pacific to provide an updated privilege log with a more detailed description of the subject matter of the withheld documents.

CONCLUSION

For the reasons set forth in Global Tissue's moving paper, together with the arguments set forth hereinabove, Global Tissue's motion should be granted, and the Board should issue an Order compelling Georgia-Pacific to produce additional witnesses to allow completion of the already-order 30(b)(6) deposition, and to provide an updated privilege log in accordance with the revisions of Rule 26.

Dated: July 6, 2010

Hoffmann & Baron, LLP
6900 Jericho Turnpike
Syosset, New York 11791
Telephone: (516) 822-3550
Facsimile: (516) 822-3582
choffmann@hoffmannbaron.com
gschroeder@hoffmannbaron.com

Respectfully submitted,



Charles R. Hoffmann
R. Glenn Schroeder

Attorneys for Applicant
Global Tissue Group, Inc

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this date, July 6, 2010, a copy of the foregoing
REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO COMPEL
DISCOVERY was served upon the Opposer, by email and by U.S. mail, to Opposer's current
identified counsel, as set forth below:

R. Charles Henn, Jr., Esq.
Kilpatrick Stockton, LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309
chenn@kilpatrickstockton.com

A handwritten signature in black ink, appearing to read 'R. Glenn Schroeder', written over a horizontal line.

R. Glenn Schroeder